

Serial No. 09/727,117

Atty. Docket No. Mo 6049

REMARKS

Applicants respectfully request reconsideration and reexamination of the present application in light of the amendments and the remarks below.

Claims 9-20 are pending in this application. Claims 13, 14, 15, 18, 19, and 20 have been cancelled. Claims 9, 10, 11, 12, 16, and 17 have been amended. These claim amendments are made to clarify the subject matter therein. Therefore, these amendments are submitted in order to place the claims in condition for allowance, and do not disclaim any subject matter to which the Applicants are entitled.

Rejection Under 35 U.S.C. § 103(a)

The Examiner rejected claims 9-20 under 35 U.S.C. § 103(a) as unpatentable over Dorn, et al., (U.S. Patent No. 6,232,328) (Paper No. 20051125, pages 4-6). Applicants respectfully traverse.

The Examiner stated that Dorn, et al. teach the combination of pyrethroid and nicotinic compound specifically imidacloprid and permethrin for the control of parasitic insects such as fleas, lice and flies, which embrace presently, claimed invention. (Paper No. 20051125, page 4).

As amended, the claims relate to processes for treating a mammal or premise infected with acarids by administering a composition comprising permethrin and imidacloprid. Dorn, et al., does not teach or suggest the combination of permethrin and imidacloprid for the treating a mammal or premise infected with acarids. In fact, Dorn, et al., only describes insects such as Anoplura (sucking lice), Mallophaga (biting lice), Diptera (flies), and Siphonaptera (fleas) (see column 6, lines 31-49). Dorn, et al., does not teach or suggest acarids such as ticks and mites as described in the present invention. As one skilled in the art would appreciate, insects and acarids are distinctly different species. Indeed, insects such as fleas, lice, and flies are members of the Class Insecta, Subphylum Uniramia; whereas acarids such as ticks and mites are members of Class Arachnida, Subphylum Chelicerata (see, e.g., Zoo Lab, University of Wisconsin, and Animal Diversity Web, University of Michigan; copies previously provided). There are distinct anatomical and physiological differences between these classes. Thus, one skilled in the art would easily recognize that compounds that demonstrate activity against insects do not necessarily possess activity against acarids. Therefore, based on the disclosure of Dorn, et al., it would not have been obvious to one skilled in the art to use permethrin and imidacloprid to treat a mammal or premise infected with acarids.

Thus, the reference does not teach or suggest every element of the claimed invention, and therefore, does not support a rejection of the claims under U.S.C. § 103(a).

It is therefore respectfully submitted Dorn, et al., fail to teach or suggest the processes as presently claimed, and that the current invention is novel and nonobvious in view of the prior art

Serial No. 09/727,117

Atty. Docket No. Mo 6049

references. For the foregoing reasons, Applicants respectfully request reconsideration and withdrawal of the present rejection.

The Examiner rejected claims 9-20 under 35 U.S.C. § 103(a) as unpatentable over Dorn, et al., (U.S. Patent No. 6,232,328) in combination with Sirinyan, et al., (U.S. Patent No. 6,001,858) and Erdelen, et al., (U.S. Patent No. 5,994,331). (Paper No. 20051125, pages 6-8). Applicants respectfully traverse.

The Examiner stated that Dorn, et al. teach the combination of pyrethroid and nicotinic compound specifically imidacloprid and permethrin for the control of parasitic insects such as fleas, lice and flies, which embrace presently, claimed invention (Paper No. 20051125, page 6).

As discussed above, Dorn, et al., does not teach or suggest the combination of permethrin and imidacloprid for the treating a mammal or premise infected with acarids.

The Examiner stated that Sirinyan, et al., teaches the combination of imidacloprid and permethrin for the dermal control of parasitic insects (Paper No. 20051125, pages 6-7).

As discussed above, the claims relate to processes for treating a mammal or premise infected with acarids by administering a composition comprising permethrin and imidacloprid. However, Sirinyan, et al., does not teach or suggest the combination of permethrin and imidacloprid for the treating a mammal or premise infected with acarids.

The Examiner stated that Erdelen, et al., teaches the synergistic combination of chloronicotinyl insecticide, imidacloprid and various compounds (Paper No. 20051125, page 7).

As discussed above, the claims relate to processes for treating a mammal or premise infected with acarids by administering a composition comprising permethrin and imidacloprid. However, Erdelen, et al., does not teach or suggest the combination of permethrin and imidacloprid for the treating a mammal or premise infected with acarids.

Thus, the references do not teach or suggest every element of the claimed invention, and therefore, does not support a rejection of the claims under U.S.C. § 103(a).

It is therefore respectfully submitted that Dorn, et al., either singly or in combination with Sirinyan, et al., and/or Erdelen, et al., fails to teach or suggest the processes as presently claimed, and that the current invention is novel and nonobvious in view of the prior art references. For the foregoing reasons in this section, Applicants respectfully request reconsideration and withdrawal of the present rejections.

Double Patenting

The Examiner provisionally rejected claims 9-20 under the judicially created doctrine of double patenting over claims 4-7 of co-pending Application Serial No. 10/682,127 (Sirinyan, et al.) (Paper No.

Serial No. 09/727,117

Atty. Docket No. Mo 6049

20051125, pages 3-4). The Examiner stated that this is a provisional double patenting rejection since the conflicting claims have not yet been patented.

It remains unknown what subject matter claimed and disclosed in the present application will be deemed allowable; hence any statement regarding this rejection made on Applicants' part would be premature. Therefore, Applicants respectfully traverse this rejection, and request that this rejection should be held in abeyance until subject matter is deemed allowable in this application.

CONCLUSION

For the foregoing reasons, Applicants submit that the claims are in condition for allowance and Applicants respectfully request reexamination of the present application, reconsideration and withdrawal of the present rejections, and entry of the amendments. Should there be any further matter requiring consideration, Examiner Qazi is invited to contact the undersigned counsel.

If there are any further fees due in connection with the filing of the present reply, please charge the fees to undersigned's Deposit Account No. 13-3372. If a fee is required for an extension of time not accounted for, such an extension is requested and the fee should also be charged to undersigned's deposit account.

Respectfully submitted,


Susan M. Pellegrino
Reg. No. 48,972

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Bayer Pharmaceuticals Corporation
400 Morgan Lane
West Haven, CT 06516-4175
Telephone: (203) 812-6450
Facsimile: (203) 812-6459

Serial No. 09/727,117

Atty. Docket No. Mo 6049

Amended Claims (Attorney Docket No. Mo 6049)

1. (Cancelled).
2. (Cancelled).
3. (Cancelled).
4. (Cancelled).
5. (Cancelled).
6. (Cancelled).
7. (Cancelled).
8. (Cancelled).
9. (Currently amended) A process for treating a mammal or premise infected with acarids comprising administering to the mammal or premise an effective amount of a composition comprising a ~~pyrethroid~~ permethrin and a ~~nicotinyl compound~~ imidacloprid.
10. (Currently amended) A process for treating a mammal infected with acarids comprising dermally administering to the mammal an effective amount of a composition comprising a ~~pyrethroid~~ permethrin and a ~~nicotinyl compound~~ imidacloprid.
11. (Currently amended) The process of claim 9, wherein the ~~pyrethroid~~ permethrin is in a concentration of from 0.1 to 60% by weight and the ~~nicotinyl compound~~ imidacloprid is in a concentration of 0.001 to 25% by weight, based on the overall weight of the composition.
12. (Currently amended) The process of claim 9, wherein the ~~pyrethroid~~ permethrin and the ~~nicotinyl compound~~ imidacloprid are in a single formulation.
13. (Cancelled).
14. (Cancelled).
15. (Cancelled).

Serial No. 09/727,117

Atty. Docket No. Mo 6049

16. (Currently amended) The process of claim 10, wherein ~~the pyrethroid~~ permethrin is in a concentration of from 0.1 to 60% by weight and ~~the nicotinyl compound~~ imidacloprid is in a concentration of 0.001 to 25% by weight, based on the overall weight of the composition.
17. (Currently amended) The process of claim 10, wherein ~~the pyrethroid~~ permethrin and ~~the nicotinyl compound~~ imidacloprid are in a single formulation.
18. (Cancelled).
19. (Cancelled).
20. (Cancelled).